

ESTTA Tracking number: **ESTTA261469**

Filing date: **01/20/2009**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92048989
Party	Plaintiff Top Tobacco, LP
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Date	01/20/2009
Attachments	Reply in Support of Motion.pdf (7 pages)(261155 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

TOP TOBACCO, L.P.,)	
)	
Petitioner,)	
)	
v.)	Consolidated Cancellation No. 92048989
)	
VAN NELLE TABAK NEDERLAND BV,)	
)	
Respondent.)	

**REPLY IN SUPPORT OF TOP TOBACCO'S
MOTIONS TO COMPEL DISCOVERY
AND FOR EXTENSION OF DISCOVERY AND TRIAL PERIODS**

In this case, Top Tobacco, L.P., ("Top") asserts that Respondent has no intent to resume use (or even use in the first instance) the mark ROUTE 66, which Respondent has warehoused for many years, and that is the subject of the '896 and '623 registrations. Accordingly, Top served discovery requests directed to Respondent's acquisition, use (if any), and abandonment of the ROUTE 66 Mark in any and all forms, including those that are the subject of the '628 and '437 registrations. In response, Respondent has refused to produce any information relating to the mark prior to February 6, 2003. This position is untenable because it ignores the fact that the circumstances regarding Respondent's acquisition, non-use, and pattern of filings designed to warehouse the mark all bear directly on Respondent's purported intent to use or resume use of the ROUTE 66 Mark in United States commerce.

In its response to the present motion, Respondent fails to offer any meaningful explanation why the requested documents and information are not reasonably calculated to lead to the discovery of admissible evidence; nor does it provide any other justification for its refusal to produce documents and information relevant to its efforts to reserve the ROUTE 66 Mark. Top should be entitled to conduct discovery into Respondent's questionable acquisition of rights

in the ROUTE 66 Mark, its long history of non-use of the mark, and its repetitive filings for the mark, all of which would result in objective, circumstantial evidence pertaining to Respondent's intent. Accordingly, Top's motion to compel should be granted.

I. TOP IS ENTITLED TO DISCOVERABLE INFORMATION REGARDING USE OF THE MARK IN ANY FORM AT ANY TIME

It is well-settled that "intent not to resume [use of a mark] may be inferred from circumstances." 15 U.S.C. §1127. Thus, Top is entitled to conduct discovery into objective information that may illustrate this lack of intent, as it relates to Top's claim of abandonment. The fact that Respondent and its predecessor may have acquired its first of four registrations for the ROUTE 66 Mark under questionable circumstances, made three additional filings – the first of which occurred in the mid-1990s – and apparently never used the mark in this country suggests a pattern that belies any genuine bona fide intent to actually use, or resume use, of the mark in the United States. *See, e.g.,* S. Rep. 100-515, 1988 U.S.C.C.A.N. 5577 (describing circumstances that suggest the absence of a genuine bona fide intent to actually use a mark). Thus, Top's discovery requests directed to Respondent's acquisition of rights in the mark, its use and contemplated use (if any) of the mark before 2003, and agreements relating to the mark before 2003, are all directly relevant to Respondent's purported good faith intent to use, or resume use, of the mark. They are certainly, therefore, calculated to the discovery of admissible evidence.

In its Response, Respondent concedes that information and documents pertaining to its use and intent to use the ROUTE 66 Mark in any form is relevant. Resp. at 2. In fact, Respondent only challenges the timeframe for this information, drawing the line at February 6, 2003, based on the filing dates of Registration Nos. '896 and '623. *Id.* This position cannot stand because there are a number of facts that raise questions about Respondent's conduct, and

suggest that it is inappropriately reserving the mark. Indeed, it has made numerous filings that have kept the ROUTE 66 Mark in Respondent's stockpile, even though it may have never used the mark. In addition, as conceded by Respondent in its Response, the prosecution history files show that Respondent claimed ownership of the '628 and '437 registrations to support its applications that resulted in the '623 and '896 registrations, (*see* Resp. at 3-4) when in fact, it appears that Respondent either knew or should have known that the '628 registration should have been cancelled for lack of use. Further, these same prosecution history files show that Respondent submitted an apparently identical specimen in connection with the statement of use for two different registrations, namely the '628 and '437, raising a question about Respondent's actual use. All of these facts tend to show the inter-relationship between Registration Nos. '628, '437, '896 and '623 and cast significant doubt on Respondent's purported good faith intent to use the mark in commerce in the United States.

Nevertheless, Respondent argues that discovery of relevant information prior to 2003 should not be allowed, and in effect, limiting discovery in this matter to the vacuum encompassing Registration Nos. '896 and '623. For example, under Respondent's view, information regarding ROUTE 66 in word form in 2003 and thereafter is relevant because it is the subject of Registration No. '623. On the other hand, under Respondent's view, information regarding the exact same mark, ROUTE 66 in word form, prior to 2003 is not relevant because it is the subject of a different registration, No. '437, which is not part of this proceeding. Yet, both pertain to the ROUTE 66 Mark in word form. In other words, Respondent argues that one is not relevant merely because the registration number is different, and, by doing so, would effectively prevent discovery of facts pertaining to its warehousing the mark without any intent to actually use it.

Such an artifice is not sanctioned by the rules of discovery that permit inquiry into areas that may lead to the discovery of admissible facts, nor is it supported by the authority cited by Respondent. In fact, the cases relied upon by Respondent for its assertion that “the relevant time frame with respect to Top Tobacco’s abandonment claims would begin when the ‘896 and ‘623 registrations actually issued” do not support the position that facts prior to 2003 are not discoverable. As previously shown by Top in its Motion, *Consolidated Cigar Corp v. Rodriguez*, addressed the question of whether the time while an intent-to-use application is pending and prior to the filing of a statement of use could be considered part of the statutory three-year period that creates the presumption of abandonment. 65 USPQ2d 1153, 1155 (TTAB 2002). The Board held that it did not, and denied the motion for summary judgment. *Id.* at 1155-56. Here, the matter before the Board is not summary judgment, nor is Top suggesting that the beginning of the non-use period for the purposes of the statutory presumption of abandonment be back-dated. Top is merely seeking to lift the veil put in place by Respondent and gain discovery as to the facts and circumstances that belie Respondent’s intent to use the ROUTE 66 Mark.

Similarly, *Hawaiian Host v. Roundtree MacKintosh PLC*, which also involved summary judgment, held that a Section 44(e) applicant did not have to use the mark prior to registration, and thus evidence of non-use prior to the filing of the subject application was not relevant to the proceeding involving the application. 225 USPQ 628, 630 (TTAB 1985). That is not at issue here because Top is not arguing that Respondent was required to use its mark prior to registration under Section 44(e). In this situation, Top is seeking discovery – not summary judgment – on the facts and circumstances surrounding each of Respondent’s ROUTE 66 applications and

registrations and any other uses of a ROUTE 66 Mark that bear on Respondent's perpetual shelving of the ROUTE 66 Mark.

In short, Respondent seeks to prevent inquiry into its pattern of conduct that will lead to objective evidence into its true intent regarding use of the ROUTE 66 Mark, and has offered no reason why Top's discovery requests are not reasonably calculated to lead to the discovery of admissible evidence. Attempting to obscure information in this way should not be allowed. Accordingly, Top's motion to compel should be granted.

II. TOP WITHDRAWS ITS MOTION AS TO THE IDENTIFICATION OF PRINCIPALS OF COMMONWEALTH AND J.L. GADDY ENTERPRISES

On December 11, 2008, the same day that Top filed its motion to compel, Respondent supplemented its discovery responses to identify the relevant principals of Commonwealth Brands and J.L. Gaddy Enterprises, Inc. Because this supplemental information was served by U.S. Mail, Top did not receive this information until after the filing of its motion. Having now received it, this issue is moot and Top hereby withdraws the portion of its motion related to these requests.

III. THE DISCOVERY PERIOD SHOULD BE EXTENDED FOR FULL INVESTIGATION OF RELEVANT FACTS AND NOT LIMITED

As shown in its motion, Top has good cause for the extension of the trial and discovery periods in this matter, and Respondent has not shown otherwise. In fact, Respondent concedes that discovery should be extended for at least 30 days. However, contrary to Respondent's assertion, Top should not be limited to depositions of the principals of Commonwealth Brands. Given Respondent's failure to produce relevant information in response to Top's discovery requests to include any and all forms of the ROUTE 66 Mark at any time in the United States, Top should be allowed to follow-up on this information. There have not been any previous extensions requested by either party to date in this matter, and Respondent has not shown that it

would be prejudiced in any way by a 60-day extension at this point that would allow for the full and orderly completion of discovery. Top respectfully requests, therefore, that its motion to extend the discovery and trial periods in this matter be granted in its entirety.

Respectfully submitted,

January 20, 2009

/Antony J. McShane/
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CERTIFICATE OF SERVICE

I, Hillary A. Mann, an attorney, state that I caused a copy of the foregoing, Reply in Support of Top's Tobacco's Motions to Compel Discovery and for Extension of Discovery and Trial Periods, to be served upon:

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via U.S. Mail on this January 20, 2009.

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NGEDOCs: 1593750.5